



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re Application of:

Pippig *et al.*

App. No. 09/817,487

Filed: March 26, 2001

For: **Selectable Marker Genes**

Confirmation No. 9170

Art Unit: 1646

Examiner: Ruixiang Li

Atty Docket: 4-31193A

#13
P.Q.
3/18/03

DECLARATION OF PRIOR INVENTION UNDER 37 C.F.R. § 1.131

U.S. Patent and Trademark Office
P.O. Box 2327
Arlington, VA 22202

Sir:

The inventors, Susanne Pippig and Gabor Veres, declare as follows:

1. We are former employees of Systemix, Inc., in Palo Alto, California. While employed at Systemix, we invented the invention described and claimed in U.S. Patent Application No. 09/539,248, filed March 30, 2000 (which was later converted to Provisional Application No. 60/266,331) and are therefore the named inventors thereof. We are also the named inventors of the above-captioned Application No. 09/817,487, which claims the benefit of Provisional Application No. 60/266,331.
2. It is our understanding that in a Non-Final Office Action dated Sept. 3, 2002, in Application No. 09/817,487, claims 1-4, 6-8, 10-12, and 21 were rejected under 35 U.S.C. § 102(a) as being anticipated by Zhou *et al.*, *J. Cell Biology* 146:1133-146 (September 6, 1999) and that claims 9, 14-20, 23, and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Zhou *et al.*, *J. Cell Biology* 146:1133-146 (September 6, 1999) in combination with one or more other references. We make this Declaration in a traversal of these rejections.

3. Prior to the September 6, 1999, publication date of the Zhou *et al.* paper, we conceived and reduced to practice the invention claimed in claims 1-9, 11, 12, 14, 15, 17-20, and 25-30 set forth in the accompanying Reply Under 37 C.F.R. § 1.111 responsive to the Office Action dated Sept. 3, 2002. As evidence of our prior invention, we attach hereto Exhibits A and B.

4. Exhibit A is a memorandum to us dated August 9, 1999, from Lynn Marcus-Wyner, the Systemix patent attorney who drafted parent Application No. 09/539,248, along with a draft of the application. This memorandum and draft application, particularly the “Experimental” section beginning on page 23, shows that prior to the publication date of the Zhou *et al.* paper, we conceived and reduced to practice the invention claimed in claims 1-9, 11, 12, 14, 15, 17-20, and 25-30 set forth in the accompanying Reply Under 37 C.F.R. § 1.111 responsive to the Office Action dated Sept. 3, 2002.

5. Exhibit B is an Affidavit of Lynn Marcus-Wyner, attesting to the authenticity of the memorandum and draft patent application provided as Exhibit A.

6. All statements made herein of our own knowledge are true and all statements made on information and belief are believed to be true. Further, these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

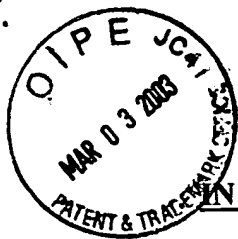
Subscribed to on the following date:

2/20/2003

SD: pp

Susanne Pippig, Ph.D.

Gabor Veres, Ph.D.



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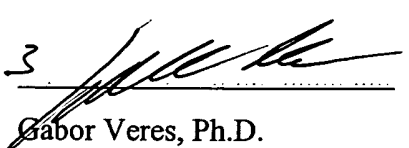
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Subscribed to on the following date:

Susanne Pippig, Ph.D.

02-24-2003



Gabor Veres, Ph.D.